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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,088	08/23/2005	Hans-Joachim Weinand	OST-041369	8836

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FACTOR & LAKE, LTD  
1327 W. WASHINGTON BLVD.  
SUITE 5G/H  
CHICAGO, IL 60607

EXAMINER
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LAMB, BRENDA A

ART UNIT	PAPER NUMBER
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1792

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/507,088	<b>Applicant(s)</b> WEINAND, HANS-JOACHIM	
	<b>Examiner</b> Brenda A. Lamb	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 9/20/07.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/507,089 in view of 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Sugane et al 2001/0019004.

Copending Application No. 10/507,089 claims a system for treating articles, comprising: treatment containers; a feed device, by means of which the articles are conveyed through the system and in the process are dipped successively into the treatment containers such that the articles may be acted upon the treatment liquid therein; the feed device comprising at least one feed carriage which in turn comprises: a running gear movable along the path of motion of the articles; at least one swivel arm hingedly coupled to the running gear; a holding or supporting device hingedly coupled to

the swivel arm for at least one article and, mutually independently actuable drives for translational movement, the swivelling of the at least one swivel arm and of the holding device. Copending Application No. 10/507,089 fails to claim that the system includes at a dripping zone downstream of the bath and a drier is disposed downstream of the dripping zone. However, it would have been obvious to modify Copending Application No. 10/507,089 apparatus to provide a dripping zone downstream of the bath and a drier is disposed downstream of the dripping zone since Sugane et al shows arranging a dripping zone downstream of the bath and a drier is disposed downstream of the dripping zone for the obvious reason to enable one to coat the article with different coating materials without cross-contamination of the coating material between the coating stations which apply different coating materials.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/507,090 in view of 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Sugane et al 2001/0019004 and Fessler.

Copending Application No. 10/507,090 claims a system for treating articles, comprising: treatment container; a feed device, by means of which the articles are conveyed through the system, and in the process are introduced and removed from the treatment container such that the articles may be acted upon the treatment liquid therein, the feed device comprising at least one feed carriage which in turn comprises: running gear movable along the path of motion of the articles; at least one swivel arm coupled to the running gear; a holding or supporting device coupled to the swivel arm

for at least one article and, mutually independently actuable drives for translational movement, the swivelling of the at least one swivel arm and of the holding device. Although Copending Application No. 10/507,090 fails to claim the swivel arm is hingely coupled to the running gear and holding device is hingely coupled to the swivel arm, it would have been prima facie obvious to hingedly connect elements of the Copending Application No. 10/507,090 apparatus such that the elements can move independently from each other since it is known to do so and if necessary is disclosed by Fessler (see column 5 lines 50-64, column 8 lines 40-54 and Figure 8). Further, Copending Application No. 10/507,090 fails to claim that the treatment container is a bath with a dripping zone arranged downstream of the bath and a drier is disposed downstream of the dripping zone. First, it would have been obvious to modify Copending Application No. 10/507,090 apparatus by using the treatment container as a bath since Sugane et al shows it is known to treat articles within a treatment container for the obvious advantage of immersion coating – treat all external surfaces of the article by full immersion into the bath. Further, it would have been obvious given the modified Copending Application No. 10/507,090 apparatus to provide a dripping zone downstream of the bath and a drier is disposed downstream of the dripping zone since Sugane et al teaches arranging a dripping zone downstream of the bath and a drier is disposed downstream of the dripping zone for the obvious reason to enable one to coat the article with different coating materials without cross-contamination of the coating material between the coating stations which apply different coating materials.

This is a provisional obviousness-type double patenting rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The originally filed specification at paragraph 0011 discloses that system for treating articles including a feed device which is comprised of at least one feed carriage and the feed carriage acts as a tilting apparatus yet claim 1 at lines 5-7 and 10-12 sets forth that the tilting apparatus and feed carriage are separate elements of the system which is confusing. Claim 1 is confusing since it is unclear how the drive for the running gear set forth at lines 12-13 relates to the mutually independently actuatable drives set forth at lines 16-17.

Applicant's arguments filed 9/20/2007 have been fully considered but they are not persuasive.

Applicant's argument that Sugane et al fails to teach a dipping zone arranged downstream of the bath and upstream of the drier is found to be non-persuasive. Sugane et al teaches that downstream of the bath that the article tilts into an angular position via the feed carriage relative to the horizontal that is suitable for dripping off excess coating which is upstream of drier D or drier F.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday. The examiner can also be reached on alternate Wednesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton, can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Brenda A Lamb". The signature is written in a cursive, flowing style.

Brenda A Lamb  
Primary Examiner  
Art Unit 1792